

Remarks

This is in response to the Office Action dated April 29, 2009. Claims 1, 2, 12 and 19, have been amended to clarify that the circulators, demodulators and filters are arranged in series.

The Examiner rejected claims 1-19 of the application under 35 U.S.C. 103 (a) as being unpatentable over Scott (U.S. 6,522,642) in view of Upton (U.S. 6,721,506).

We respectfully submit the rejection is deficient and should be withdrawn for failing to present a *prima facie* case of obviousness. According to section 2141 of the MPEP, which cites the recent Supreme Court Decision in *KSR*:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. Exemplary rationales that may support a conclusion of obviousness include:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

We respectfully submit the rejection fails to articulate sufficient reasoning with a sufficient underpinning to support the legal conclusion of obviousness. The only reasoning articulated by the examiner is:

"It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a plurality of circulators, such as suggested by Upton, to the system of Scott in order to provide a more efficient and increased performance communication system (see summary)."

This fails to articulate a reasoning with sufficient specificity to support a legal conclusion of obviousness. The examiner is effectively saying Scott does not teach a system that uses circulators, but Upton does and it would be obvious to combine them to improve the state of the art. This does not satisfy any of the 7 rationales (A-G) listed.

Indeed, even USPTO training materials acknowledges that simply providing a general motivation statement constitutes an improper rejection based on hindsight. Section V of <http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm> lists as an example of an improper rejection:

" The motivation, to improve efficiency, is too general because it could cover almost any alteration contemplated of Reference A and does not address why this specific proposed modification would have been obvious."

In any event, we submit an ordinary worker skilled in the art would NOT be motivated to add the circulators as taught in Upton to the system taught by Scott, as there would be no reason

to do so. Upton is using the circulators as part of an arbitrary waveform generator, which has nothing to do with the Walsh coded signals in the antenna diversity system of Scott. We do not see how adding Upton's circulators could serve any purpose in Scott's system.

In any event, we submit that the rejection is now moot, as we have amended the claims to clarify that the circulators, demodulators and filters are arranged in series. We respectfully submit that a person skilled in the art would have no motivation to combine the teachings of Scott with teachings of Upton to achieve the claimed invention, as neither reference teaches or suggests arranging circulators, demodulators and filters in series.

Accordingly, we respectfully submit that the claims are allowable over the cited art, and a notice thereof is hereby requested.

The Commissioner is hereby authorized to charge any additional fees, and credit any over payments to Deposit Account No. 14-1315, in the name of Nortel Networks.

Respectfully submitted,

DEANE, Peter et al.

By: /Jeffrey M. Measures/
Jeffrey M. Measures
Reg. No. 40,272
Borden Ladner Gervais LLP
World Exchange Plaza
100 Queen Street, Suite 1100
Ottawa, ON K1P 1J9
CANADA
Tel: (613) 237-5160
Fax: (613) 787-3558
E-mail: ipinfo@blgcanada.com

JMM/mwb